

REMARKS/ARGUMENTS

In the Office Action mailed May 12, 2009, claims 1, 5-6, 10-11 and 15-29 were rejected by the Examiner. Claim 1 has been amended, support for which may be found in the specification, for example, at paragraphs [0017], [0019]-[0021], and [0023]. No new matter has been added to the application. Applicants respectfully traverse the rejections.

Applicants have thoroughly reviewed the outstanding Office Action including the remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

CLAIM REJECTIONS – 35 U.S.C. §101

Claims 1 and 5 stand rejected under 35 U.S.C. §101. Claim 1 has been amended. The steps of method claim 1 reciting comparing, determining, and identifying have been tied to a particular machine. Further, the method recites more than one machine, the computing device and the vehicle diagnostic equipment. As discussed in the BPAI's decision in *Ex parte Wasynczuk*, 87 U.S.P.Q.2d 1826, 1833 (B.P.A.I. 2008), "Appellants' claims recite a process that employs one of the other statutory categories." The claims of *Ex parte Wasynczuk* recited two physical computers, of which the BPAI said:

we conclude is "a particular apparatus" to which the process is tied, not simply a generic computing device for performing the steps. . . . Because the claim recites a particular apparatus, (1) the method operates on another class of statutory subject matter such that the method is a patentable 'process', and (2) the method is not directed to an abstract idea. . . . Accordingly, the claims meet the conditions set forth in the case law of the Supreme Court and the Federal Circuit.

Thus, [the] claims . . . do not fall outside the scope of § 101. (*Ex parte Wasynczuk*, 87 U.S.P.Q.2d at 1833-34).

Like the claims of *Ex parte Wasynczuk*, claim 1 recites two elements from another statutory category comprising a specific machine, a computing device and a vehicle diagnostic equipment.

In light of the above amendments and remark, Applicants consider claim 1 to be in condition for allowance and respectfully request withdrawal of this rejection. Claim 5 depends directly from claim 1 and is therefore also allowable.

CLAIM REJECTIONS – 35 U.S.C. §103

Claims 1, 5, 6, 10, 11 and 15-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li (U.S. Patent Application Publication No. 2002/0072808) in view of Kirkevold *et al.* (U.S. Patent No. 6,263,322; “Kirkevold”).

Without submitting to the propriety of the rejection, Applicants proffer that the current invention was conceived at least as early as July 6, 1998, before the earliest filing data of Li (filed on January 20, 2000) and the earliest filing date of Kirkevold (filed on July 7, 1998). Applicants submit the attached 37 C.F.R. §1.131 declarations and supporting documents confirming the date of conception predates the filing dates of these cited references. As such, Li and Kirkevold cannot be prior art references because they do not disclose or describe the subject matter of the application as set forth in 35 U.S.C. §102, nor are the differences between the subject matter sought to be patented and the cited references such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

In light of the attached 37 C.F.R. §1.131 declarations and supporting documents, and the above remark, Applicants believe claims 1, 6, and 11 are in condition for allowance and respectfully request that this rejection be withdrawn.

Claims 5 and 20 depend directly or indirectly from claim 1, claims 10 and 21-25 depend directly or indirectly from claim 6, and claims 15-19 and 26-29 depend directly or indirectly from claim 11. In light of the attached 37 C.F.R. §1.131 declarations and supporting documents, and the above remark, Applicants believe claims 1, 6, and 11 are in condition for allowance. Thus, these dependent claims are also allowable.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request that all the objections and rejections to the claims be removed and that the claims pass to allowance. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1610 in an effort to resolve any matter still outstanding before issuing another action. The undersigned Attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87354.1581.

Respectfully submitted,
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